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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/441,236    11/16/99    SANDIFER    M    032892ATP002

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EXAMINER

LINTZ, P

ART UNIT

PAPER NUMBER

2171

DATE MAILED:

10/13/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/441,236

Applicant(s)

Sandifer

Examiner

Paul Lintz

Group Art Unit

2771



☒ Responsive to communication(s) filed on Nov 16, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-7 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-7 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**  
**IMPROPER APPENDIX**

1. Applicant's appendix on pages 124-153 is not a computer listing. The only provision made for an appendix in a United States patent application is for a computer listing appendix or a sequence listing. By inference, since no provisions are made for any other type of Appendix, such as reference manuals, dissertations, journal articles, et cetera,, no other type of Appendix is allowable. If applicant wants the information published in pages 124-153, he must either convert it to a table and remove all references to an appendix or otherwise put the information into an acceptable format.

***Double Patenting***

2. **The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).**

**A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).**

**Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).**

3. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 et alia of U.S. Patent No. 5,987,474. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of claim 1 encompasses the scope of the claims of the instant invention. That is to say, an

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infringer of the instant invention would also be an infringer of the invention claimed in the '474 patent.

#### **PRIOR ART MADE OF RECORD**

4. McGuire et al. (Us 4,404,639) disclosed an automotive diagnostic system. The Abstract and Disclosure are relevant.
5. Boscove et al. (US 4,796,206) disclosed an AI based Vehicle service system. The Abstract and Disclosure are relevant
6. Aslin et al. (US 4,943,919) disclosed a centralized maintenance computer with fault handling. The Abstract and Disclosure are relevant
7. Cassorla et al. (US 5,146,552) disclosed a method of annotating electronic documents. The Abstract and Disclosure are relevant.
8. Gordon et al. (US 5,195,173) disclosed an expert system for maintenance advice. The Abstract and Disclosure are relevant.
9. Lewis (US 5,666,481) disclosed fault resolving in communication networks. The Abstract and Disclosure are relevant.
10. Sandifer (US 5,778,381) is the parent patent of the present invention.
11. Skorupski et al. (US 5,680,328) disclosed a computer-aided vehicle inspection facility. The Abstract and Disclosure are relevant.
12. Sandifer (US 5,987,474) was used to reject claims.

#### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

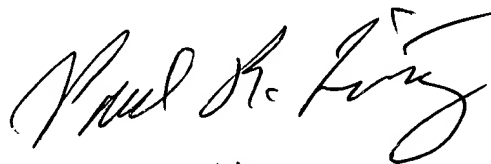
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### POINTS OF CONTACT

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Paul R. Lintz whose telephone number is (703) 305-3832. The Examiner can normally be reached on Mondays through Fridays from 8:00 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black, can be reached at (703) 305-9707. The fax phone number for Art Unit 2307 is (703) 305-9731. NOTE: Documents transmitted by facsimile will be entered as official documents on the file wrapper unless clearly marked "DRAFT".

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.



Paul R. Lintz  
Primary Examiner



Paul R. Lintz  
Patent Examiner  
Art Unit 2307  
October 5, 2000